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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,108	05/24/2001	Craig S. Skinner	24530.01800	3048
7590	05/19/2005		EXAMINER	
John W. Carpenter CROSBY, HEAFY, ROACH & MAY P.O. Box 7936 San Francisco, CA 94120-7936			SHARMA, SUJATHA R	
			ART UNIT	PAPER NUMBER
			2684	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/865,108	SKINNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sujatha Sharma	2684	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### **Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 21 December 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 15,17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the limitation “displaying the enablement status of the RF device using an icon that comprises an airplane”, which is new subject matter not described in the specification.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11,12 are rejected under 35 U.S.C. 102(e) as being anticipated by DaSilva [US 6,496,703].

Regarding claims 11,12, DaSilva discloses a method of notifying a user of an RF enablement of a device comprising the steps of:

- identifying the invocation of a mechanism requiring access to the RF capabilities and determining the RF enablement of the RF device; see col. 9, lines 43-50
- prompting a user of the device if the mechanism is to be granted RF access; see col. 9, lines 43-50 where the user is prompted to make the call if the call is an outgoing emergency call
- retrieving a user input regarding whether RF access should be granted to the mechanism requiring RF access; see col. 9, lines 43-50 where the RF access is granted if the user input is a 911 call
- if the user input indicates the mechanism is to be granted RF access, automatically enabling the RF device and allowing the mechanism requiring RF access to continue and access the RF device; see col. 9, lines 43-50
- if the user input indicates the mechanism should not be granted RF access, then, shutting down the mechanism requiring RF access without enabling the RF device. see col. 9, lines 43-50

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,13,16 rejected under 35 U.S.C. 103(a) as being unpatentable over Orimo [JP 7303134] in view of Mauney [US 6,484,027] and further in view of LaGrotta [US 6,477,361].

Regarding claims 1,13 Orimo discloses a portable phone with various functional settings.

Orimo further discloses a portable phone comprising:

- a radio unit configured to communicate with a network; See Fig.2 and paragraph 9 of English translation
- at least one memory device configured to store application and system programs; See Fig.2 and paragraph 11
- a processing unit coupled to said radio unit and said at least one memory device, said processing unit configured to run the application and system programs; see Fig.2

wherein at least one of the application and system programs include a switch for enabling and disabling the radio. See paragraphs 2-23

However, Orimo does not disclose the portable phone to include a soft key for enabling and disabling the radio.

Mauney, in the same field of endeavor, teaches a method of carrying out different functionalities for example for turning on/off of the mobile phone using soft keys. See Fig. 4A and col. 13, line 34 – col. 14, line 5.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Mauney to Orimo in order to provide a user with greater flexibility and optimum performance.

Orimo and Mauney together fail to disclose a method wherein a software-enabled switch is used for enabling and disabling the radio unit while leaving the processing unit in an operational state.

LaGrotta, in the same field of endeavor, teaches a method wherein during the on/off cycle of the portable unit, the pager goes into a sleep mode and does not monitor signals. See col. 4, lines 3-30.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of LaGrotta to modified Orimo in order to track the time duration of the sleep mode and upon completion of sleep mode goes back up to power on mode to receive incoming calls/messages.

Regarding claim 4, Mauney further discloses the electronic device to comprise of a display screen and at least one of said system and application programs configured to generate a graphical user interface on the display screen having at least one soft button programmed to enable and disable said radio device. See Figs 4A, 4B and col. 13, line 54 – col. 14, line 5.

Regarding claim 5, Mauney further discloses a graphical user interface having a first soft button entitled “radio on” and a second soft button labeled “radio off” and an enablement of the radio device is indicated by the corresponding indicators. See col. 13, lines 48-61.

Regarding claims 9,10, Orimo further discloses a method wherein the drop down menu includes an option for schedule and the application and system programs include a scheduling

application that provides user modifiable start and stop times that indicate when the radio unit is to be enabled and disabled. See English translation of the document page 2, paragraphs 18-21.

Regarding claim 16, LaGrotta further teaches a method wherein the electronic device according comprises a shutdown device configured to maintain the radio unit in a non-enabled state, maintain the processing unit in an operational state, and shut down an application program that utilizes the radio unit upon a negative response to the prompt from the user. See col. 4, lines 3-30 and col. 9, lines 43-40.

5. Claims 2,3,14 rejected under 35 U.S.C. 103(a) as being unpatentable over Orimo [JP 7303134] and Mauney [US 6,484,027] in view of LaGrotta [US 6,477,361] and further in view of DaSilva [US 6,496,703].

Regarding claims 2,14, Orimo discloses a portable phone with various functional settings. Orimo further discloses a portable phone comprising:

- a radio unit configured to communicate with a network; See Fig.2 and paragraph 9 of English translation
- at least one memory device configured to store application and system programs; See Fig.2 and paragraph 11
- a processing unit coupled to said radio unit and said at least one memory device, said processing unit configured to run the application and system programs; see Fig.2

wherein at least one of the application and system programs include a switch for enabling and disabling the radio. See paragraphs 2-23

However, Orimo does not disclose the portable phone to include a soft key for enabling and disabling the radio.

Mauney, in the same field of endeavor, teaches a method of carrying out different functionalities for example for turning on/off of the mobile phone using soft keys. See Fig. 4A and col. 13, line 34 – col. 14, line 5.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Mauney to Orimo in order to provide a user with greater flexibility and optimum performance.

Orimo and Mauney together fail to disclose a method wherein a software-enabled switch is used for enabling and disabling the radio unit while leaving the processing unit in an operational state.

LaGrotta, in the same field of endeavor, teaches a method wherein during the on/off cycle of the portable unit, the pager goes into a sleep mode and does not monitor signals. See col. 4, lines 3-30.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of LaGrotta to modified Orimo in order to track the time duration of the sleep mode and upon completion of sleep mode goes back up to power on mode to receive incoming calls/messages.

However, Orimo as modified by Mauney and Lagrotta, does not disclose a method wherein at least one of said application and system programs comprises a notification program configured to notify a user if the radio is disabled upon invoking a program that utilizes the radio.

DaSilva, in the same field of endeavor, teaches a method wherein at least one of said application and system programs comprises a notification program configured to notify a user if the radio is disabled upon invoking a program that utilizes the radio. See col. 9, lines 43-50.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of DaSilva to modified Orimo in order to prevent the usage of the portable phone in restricted or prohibited area.

Regarding claims 3, DaSilva further discloses a method wherein said notification program is further configured to give the user an option to either continue executing the application or system program and automatically enable the radio device or discontinue execution of the application or system program and leaving the radio disabled. See col. 9, lines 43-40, where the user is given the option to enable the radio even though the radio is in a restricted zone if the user is making an emergency 911 call.

4. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orimo [JP 7303134] and Mauney [US 6,484,027] in view of LaGrotta [US 6,477,361] and further in view of Graham [EP 817 447 A1].

Regarding claims 6-8, Orimo as treated in claim 1 discloses all the limitations as claimed. However he is silent to teach a method wherein the electronic device comprises a hard button programmed to enable and disable the radio device by engaging the hard button for a pre-determined length of time, wherein the pre-determined length of time is less than one second.

Graham, in the same field of endeavor, teaches a method wherein the electronic device comprises a hard button programmed to enable and disable the radio device by engaging the hard button for a pre-determined length of time, wherein the pre-determined length of time is less than one second. See col. 3, line 46 – col. 4, line 23.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teaching of Graham to modified Orimo in order to ensure that the electronic device is not inadvertently turned on/off.

*Response to Arguments*

6. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tou [US 2002/0082061]      Communication module with a retractable antennae and method therefor

Ranta [US 6,832,093]      Method and system for restricting the operation of a radio device within a certain area

Nakamura [US 6,085,096]      Mobile communication system

Maruyama [JP 2000287274]      Radio portable terminal and control method for the radio portable terminal

Takemura [US 6,188,883]    Cellular type mobile communication system that provides communication restriction command codes along with base station ID codes for base stations where mobile communication is restricted

8.    Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is 571-272-7886. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sujatha Sharma  
May 5, 2005

  
NAY MAUNG  
SUPERVISORY PATENT EXAMINER